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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,081	07/10/2001	Ashwani Chhibber	02581-P0392A	7798

24126 7590 03/26/2003

ST. ONGE STEWARD JOHNSTON & REENS, LLC  
986 BEDFORD STREET  
STAMFORD, CT 06905-5619

EXAMINER

MULCAHY, JOHN M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/902,081

Applicant(s)

CHHIBBER ET AL.

Examin r

John M. Mulcahy

Art Unit

3739

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shimonaka (JP 55-81317) as set forth in section 2b of the previous Office action (Paper Number 7).

Shimonaka's shaft 4 is described as "hard", which the artisan would equate with Applicant's definition of bend-resistant on page 10 of the instant specification. Further, as shown in Fig. 1, the shaft has a continuously curved portion extending from the distal end and extending along the shaft to a transition point (at approximately the location of the lead line for reference number 6), and a straight portion extending along the length of the shaft from the transition point to the proximal end.

3. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adair (5,329,940) as set forth in section 2b of the previous Office action (Paper Number 7).

Adair's shaft, though "malleable," "will maintain the customized shape during the intubation process" (see col. 7, lines 64-65) and thus meets Applicant's definition of bend-resistant on page 10 of the instant specification (i.e., "has a form stability such that when used for its intended purpose, i.e., intubation, it does not bend"). Further, the shaft has a continuously curved portion extending from the distal end and extending

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along the shaft to a transition point (at approximately the location of the end of the adapter 48), and a straight portion extending along the length of the shaft from the transition point to the proximal end (see col. 6, lines 44-50: the proximal end of the shaft 28 must be straight in order to fit into the straight passageway 46 of handle 26).

***Claim Rejections - 35 USC § 103***

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adair (5,329,940) as applied to claim 1 above, further in view of Chatenever et al. (WO 98/46117).

Adair fails to locate the camera at the proximal end of the shaft 28. Rather, the camera is in a separate unit 36. However, Chatenever et al. teach an endoscope having a video camera arranged at the proximal end of the shaft and removable therefrom. It would have been obvious to the artisan to modify Adair by using the camera system of Chatenever et al. in order to realize the advantages described therein.

5. Claims 10-11 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Shimonaka (JP 55-81317) or Adair (5,329,940) as applied to claim 1 above, further in view of Barthel et al. (5,921,917).

Shimonaka and Adair each fail to teach a diameter within the claimed range. However, Barthel et al. shows an analogous intubation system having a shaft with a diameter of 2.5 mm (col. 8, lines 30-35). It would have been obvious to the artisan to

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modify Shimonaka by using a shaft having a diameter in the claimed range since Barthel et al. teaches such to be preferable.

As to claim 11, although Barthel et al. fails to teach a diameter of 2 mm, inasmuch as the art recognizes shaft diameter as a result-effective variable, it would have been obvious to optimize the diameter of the shaft in order to be able to intubate still smaller passageways. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

6. Applicant argues that both Shimonaka and Adair fail to show a substantially bend-resistant shaft that has a continuously curved portion followed by a straight portion. However, this is not the case. See the above rejections.

7. Applicant's remaining arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Pertinent Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barthel et al. (5,941,816) shows an analogous intubation system and teaches that the shaft may be either malleable or not malleable. See col. 7, lines 7-26.

***Final Rejection***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

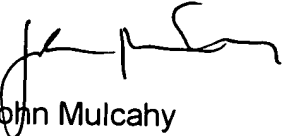
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John Mulcahy  
March 24, 2003

John M. Mulcahy  
Primary Examiner  
Art Unit 3739